REMARKS

Applicants respectfully request reconsideration of this application in view of the amendments and remarks made herein. Attorneys for Applicants wish to take this opportunity to thank the Examiner for taking the time to interview this case on April 5, 2005.

Claims 1- 37 are canceled and new claims 38-44 have been added. New claim 38 currently contains the claim language suggested by the Examiner during the April 5, 2005 interview concerning previously pending claim 19. No new matter has been added by new claims 38-44. Applicants respectfully submit that the present new claims are drawn to the previously elected groups and are supported by the original disclosure of this application. As such, no new matter has been added by these claims.

Interview Summary

On April 5, 2005 an interview was conducted by Examiner Stuart Baum and Attorneys for Applicants, Anthony Giaccio and Carmella Stephens. Claims 19-23 and 34-37 were discussed. In particular, the Examiner suggested modification of previously pending claim 19, which has been cancelled and replaced by claim 38. During the interview, Attorneys for Applicants reserved Applicants' right to prosecute claims drawn to a method of transforming trees to modify tree height and or internode length (as opposed to decrease) using expansin encoding nucleic acid sequences in anti-sense orientation (as opposed to sense orientation). It was noted that none of the other proposed modifications to the claims narrowed the scope of the claims. In fact, deletion of the GenBank Accession Number, "parts thereof" and "sufficient homology to" were actually broadening the scope of the claims.

Information Disclosure Statement

The Examiner has indicated that the reference of Stewart et al., (1995), which was identified and provided to the Examiner in the Information Disclosure Statement filed August 26, 2004, was not considered because the full citation was not provided and the information could not be ascertained from the supplied document. The full citation for the Stewart et al. reference is as follows: (Stewart et al., "*Spectroscopic Analysis of Plant Cell Walls*" Scottish Crop Research Institute Annual Report 1994, Editors: D.A. Perry and T.D. Heilbronn, © Scottish Crop Research Institute 1995). Enclosed for the Examiner's convenience is a PTO-Form 1449 for the Examiner to initial so that this previously disclosed reference can be made of record in this application.

Claim Rejections

1. 35 U.S.C. § 112, first paragraph

The Examiner rejected claims 19-23 and 34-36 as not being adequately described in the specification in such a way to convey to one skilled in the art, at the time the application was filed, that the Applicants had possession of the claimed invention. According to the Examiner, Applicants have not disclosed an assay other than transforming a gymnosperm or dicot tree with said sequence to determine if said sequence causes tree height and/or internode length to be decreased when the sequence is expressed in the tree. According to the Examiner, the claims are drawn to all sequences that are a part of SEQ ID NO:9 or are homologues of said sequence; Applicants have only disclosed sequences that have expansin activity, *i.e.*, over-expression of said sequences in a gymnosperm or dicot causes a decrease in tree height and or internode length; and Applicants have not disclosed "parts thereof" that have the specified activity.

The Examiner rejected claims 19-23 and 34-37 as not enabled for claims broadly drawn to a method of transforming trees to modify fiber characteristics comprising transforming a plant with a nucleic acid sequence comprising SEQ ID NO:9, parts thereof, sequences substantially similar thereto and having the same function, or combinations thereof, or a seed of a tree transformed therewith.

Applicants respectfully disagree with the Examiner's rejections. However, to expedite the allowance of claimed subject matter, Applicants have canceled the rejected claims and replaced them with new claims. Applicants believe that new claim 38 satisfies each of the Examiner's concerns. Applicants reserve the right to continue to pursue the subject matter of canceled claims 1-37 without prejudice in a continuing application.

New claim 38 recites a method that utilizes an expansin nucleic acid sequence in sense orientation to decrease tree height and/or internode length wherein said nucleic acid sequence is expansin sequence cucumber Ex29 SEQ ID NO: 9 and those sequences that hybridize under medium stringency conditions to the cucumber Ex29 expansin sequence of SEQ ID NO:9 and encode an expansin that decreases tree height and/or internode length. Additionally, as discussed with the Examiner during the interview on April 5, 2005, although "parts thereof" has been removed from the claim, such nucleotide sequences would be covered by the breath of the claim language "sequences which hybridize thereto under medium stringency conditions" to the cucumber Ex29 expansin sequence of SEQ ID NO: 9 and encode an expansin that decreases tree height and/or internode length. Lastly, although Applicants have narrowed the breath of the previously filed claims to claim only a "decrease"

in tree height and/or internode length and a nucleotide sequence in sense orientation, Applicants reserve the right to continue to prosecute this subject matter in a separate continuing application.

CONCLUSION

Applicants respectfully submit that all pending claims are presently in condition for allowance. Prompt and favorable reconsideration and allowance of all pending claims is respectfully requested.

The Commissioner is authorized to charge any fees relevant to this filing to Deposit Account No. 11-0600. The Examiner is invited to contact the undersigned to discuss any matter in this application.

Respectfully submitted,
KENYON & KENYON

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